

Confirmation no.2475

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	VAN SINDEREN <i>et al.</i>	Examiner:	Nguyen, Duc
Serial No.:	10/539,316	Group Art Unit:	2618
Filed:	June 15, 2005	Docket No.:	NL021368US1 (NXPS.504PA)
Title:	MIXER SYSTEM WITH AMPLITUDE-,COMMON MODE- AND PHASE CORRECTIONS		

**REQUEST FOR WITHDRAWAL OF FINALITY, AMENDMENT, AND
RESPONSE TO FINAL OFFICE ACTION**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Customer No. 65913

Dear Sir:

Applicants are in receipt of a final Office Action dated August 24, 2009, in this application. In this Request for Withdrawal of Finality, filed concurrently with Amendment and Response to Final Office Action, Applicants request that the finality of the subject Office Action be withdrawn because the Office has expressly refused to address claims 1-5 and 7 which stand rejected under §112(1) for lack of written description, on the merits for compliance with the other statutory requirements. As a result, the Office has failed to consider the patentability arguments presented in the most recently filed Amendment and Response and has failed to address or withdraw the §103(a) rejection of claim 7 for which the examiner has not asserted prior art.

The Office's final action also states that arguments to the previously asserted §103 rejections of claims 1-5 and 7 need not be considered until the §112(1) rejection is resolved; this improper position admits to premature finality of the current Office Action.

In support of this request, Applicants state the following:

Claims 1-5, 7 stand rejected under §103 from the previous office action. Claim 1 stands rejected under 35 U.S.C. § 103(a) over Ichihara (U.S. Patent No. 7,206,360) in view of Birleson (U.S. Patent No. 6,177,964); claims 2-5 stand rejected under 35 U.S.C. § 103(a) over the '360 and '964 references and further in view of the '778 reference; claim 7 stands rejected under 35 U.S.C. § 103(a) over the '360, 964, and '778 references in view of Leenaert (U.S. Patent No. 6,999,745).

The Examiner erred in failing to withdraw or address a rejection that is not supported by any asserted prior art. In the response dated June 11, 2009, Applicant traversed the §103(a) rejection of claim 7 on the grounds that Leenaert (U.S. Patent No. 6,999,745) does not qualify as prior art under 103(c) because the claimed invention and the cited '745 reference "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." The final Office Action did not withdraw the § 103(a) rejection of claim 7, which now stands rejected without asserted prior art. This rejection should be withdrawn or, if not, addressed to give adequate grounds for appeal.

The Examiner further erred in failing to address previously rejected claims 1-5 on the merits. Applicant's response filed June 11, 2009, presented several arguments for traversal of the §103 rejections of claims 1-5 and 7. In response, the Office mailed a final Office Action on August 24, 2009 which stated:

As to the 103 rejection for claims 1-5, 7 since the Examiner has decided not to include any 103 rejection in this Office Action until the 112 1st rejection is resolved, there would be unnecessary to provide any response.

However, M.P.E.P. §2163 requires:

where Office personnel establish a prima facie case of lack of written description for a claim, a thorough review of the prior art and examination on the merits for compliance with the other statutory requirements, including those of 35 U.S.C. 101, 102, 103, and 112, is to be conducted prior to completing an Office action which includes a rejection for lack of written description.

Additionally, M.P.E.P. §2144 requires that limitations which do not find support in the original specification must be considered and states "[w]hen evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as

originally filed (i.e., new matter).” Failure to examine these claims on the merits prevents these claims from being fully presented on appeal with regard to the §103 rejections.

In view of the statements outline above, Applicants request that finality of the recent final Office Action be withdrawn. Should there be issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063.

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131
CUSTOMER NO. 65913

By: 

Name: Robert J. Crawford
Reg. No.: 32,122
(NXPS.504PA)